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In the Supreme Court of the United States

OCTOBER TERM, A. D. 1953.

No. .....

NEW WRINKLE, INC., and WILLIAM A. WALDIE,
Petitioners,

v.

ROBERT C. WATSON, Commissioner of Patents,
Respondent.

PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals for the District of Columbia Circuit.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, New Wrinkle, Inc., and William A. Waldie, respectfully pray that a writ of certiorari issue to the United States Court of Appeals for the District of Columbia Circuit to review the decree of that Court holding invalid for lack of invention claims in issue of the pending patent application Serial Number 653,932, filed March 12, 1946 in the name of William A. Waldie, which decision was rendered on March 19, 1953. (R. 209.)

SUMMARY OF THE MATTER INVOLVED.

The issue is whether the Patent Act of 1952, entitled "An Act to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled 'Patents'," § 103[1] changes the

[1] "§ 103. **Conditions for patentability; non-obvious subject matter.** A patent may not be obtained though the invention is not

(Continued on following page)

standard of invention. There has never been any formal statute on invention.

The opinion of the Court below (R. 209) was to the effect that the revised Patent Act of 1952 did not change the standard of invention or the area of invention.

The position of the Court below was that the Patent Act of 1952 was a mere codification without change of the previous statutes, whereas the position of petitioners is that it was a **revision** as stated in the title of the Act and **that § 103 is a wholly new provision**, setting a new standard of invention, as shown by the language of the Act and the proceedings in the Congress leading up to the enactment of the Act.[1]

The Court also held that, while no single prior art patent disclosed the invention, yet performing a process step concurrently instead of successively, by which a new result was obtained, was not invention contrary to the decisions of this Court.

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[1] "An Act to **revise** and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled 'Patents'." (Emphasis ours.) Journal of the Patent Office Society, August, 1952, Vol. 34, No. 8, p. 545; see also pp. 587-8.

(Continued from preceding page)

identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that **the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**" (Emphasis ours.)

NATURE OF THE SUBJECT MATTER.

The instant chemical invention relates to a "Catalyst," a novel composition of matter in the form of a dry powder which, when mixed with non-wrinkling oils that would not produce a wrinkle finish[1] normally, at predetermined temperatures *during the course of the making of an oil varnish*, will produce a wrinkle. The catalyst performs two functions: (a) the wrinkle catalyst reacts between its components under carefully controlled heat conditions as intended, and (b) also reacts with the oil to bring about a wrinkling oil that gives a hard and very firm wrinkle as an industrial finish coating.

No prior art patent shows this catalyst. No prior art patent shows a catalyst introduced *in the course of the heating of the oils* to make a varnish with a resin which will react with the non-wrinkling oils to provide a hard wrinkle finish and *which will react internally with itself to provide a new chemical composition.* (App. 13A.)

The economic significance of this accomplishment is not only in securing the long desired hard wrinkle, but in being able to substitute non-wrinkling oils that are cheap and available in the United States, for the expensive China or tung oils that are mainly imported from China and are difficult to secure in view of the possession of that country by the Communists.

The Waldie invention lies in the discovery of a *dry texture modifying powder composition* which may be added to a coating composition *with ordinary oils having non-wrinkling properties for the purpose of converting the non-wrinkling coating composition to one having*

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[1] A "wrinkle" finish is one that has a uniform, repetitive, series of spaced ridges formed chemically on the surface of a paint used universally on typewriters and many other machines.

wrinkling properties, without using scarce and expensive oils. (R. 43-4, 65, 81.)

DECISION OF THE DISTRICT COURT.

The District Court found that no single prior art patent showed the combination of the catalyst as a unit. (App. 15A.) No prior art patent, singly or in combination showed the *simultaneous use* of all elements of the catalyst *in the middle of the cooking of the varnish instead of at the end.* And the District Court found that no single prior art patent or combination showed the composition of the catalyst which would internally react in the presence of the heated oil and externally react with the non-wrinkling oil. (App. R. 13A, 15A.)

Two typical claims are quoted below.[1] (App. R. 5A, 7A.)

The District Court, **not finding any individual prior patent to anticipate,** found lack of patentability, saying:

> "* * * What the plaintiffs have done is add to a non-wrinkling oil or varnish simultaneously that which previously had been added sequentially * * *.

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[1] "1. A dry texture modifying powder for the conversion of non-wrinkle coating compositions to wrinkling coating compositions comprising from 2 to 3 parts by weight of an oil reactant selected from the group consisting of maleic acid, maleic acid anhydride and fumaric acid, and 1 part by weight of a texture producer selected from the group consisting of manganese borate, cobalt acetate and lead oxides." (App. 5A.)

"10. In a process of converting a non-wrinkle varnish composition to a wrinkling coating composition comprising the steps of heating the non-wrinkling varnish composition to a temperature of from 350° F. to 420° F., adding a texture modifying powder comprising from 1 to 4 parts by weight of an oil reactant selected from the group consisting of maleic acid, maleic acid anhydride and fumaric acid, and 1 part by weight of a texture producer selected from the group consisting of manganese borate, cobalt acetate and lead oxides, and heating the mixture to a temperature of from 570° to 620° for a time of approximately 30 minutes." (App. 7A.)

> Where the result accomplished is substantially the same, *steps taken concurrently or simultaneously are the equivalent of and not patentable over steps taken successively.*" (App. 15A.) (Emphasis ours.)

This last sentence is contrary to the decisions of this Court in *American Wood Paper Co. v. Fiber Disintegrating Co.*, 23 Wall. 604; *Corona v. Dovan*, 276 U. S. 358, 368-9; *Minerals Separation v. Magma Co.*, 280 U. S. 400, 403; *Kuehmsted v. Farbenfabriken of Elberfeld Co.*, 179 Fed. 701, 702-5 (7 C. A.), that **in chemistry the order of treatment is vital and that simultaneous and successive reactions are not the equivalent of one another.**

The District Court dismissed the petitioners' bill brought under U. S. R. S. § 4915[1] for want of invention on the ground experts in the art could spell out from prior patents the same combination, even though no single patent showed either the catalyst or its process of *simultaneous reaction.*

THE DECISION OF THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

The petitioners appealed to the United States Court of Appeals for the District of Columbia Circuit. The Patent Act of 1952, Title 35, U. S. C., went into effect January 1, 1953. Both parties agreed that this Act governed the decision in this case in the Court of Appeals and the Court of Appeals so treated it. (R. 194.)

The position of the appellants was that § 103 of the Patent Act of 1952 was a wholly new section on invention not found in the previous statutes setting up a new standard of invention which prevents reconstructing the invention by experts from fragments of the prior art.

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[1] See Appendix.

The Court's decision was that the Patent Act of 1952 was not a "revision" despite[1] (a) the title of the Act says that it was a "revision"; (b) a comparison of the Act, and particularly § 103, with the nearest approach of the corresponding prior statute shows it is a new provision and the creation of new standards of invention; and (c) the hearings in the Congress hereinafter presented and the semi-official "Journal of the Patent Office Society" [2] treat § 103 as a "revision" with new standards of invention.

REASONS FOR THE ALLOWANCE OF THE WRIT.

Petitioners believe that the writ of certiorari should be granted in this case for the following reasons, and accordingly the discretionary power of this Court is invoked.

New constitutional question.

I. Did the Congress intend in the Revised Patent Act of 1952, Section 103, to broaden the area of invention and the tests therefor by specifically including as invention subject matter in "the useful arts" as well as those contributions which "promote the progress of science" and thereby broaden the area of invention and establish new standards of determining this new area of invention?[3]

The issue here deals with a new standard of invention or a new area of invention, or both, under wholly new

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[1] The new law is entitled "An Act to *revise* and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled 'Patents'." (Emphasis ours.)

[2] "Journal of the Patent Office Society," Vol. 34, No. 8, August, 1952, pp. 587-8, entitled "Patent Act of 1952."

[3] "Formation of the United States," pp. 665-6-7, "Debates in the Federal Convention of 1787 as reported by James Madison," Government Printing Office, Washington, 1927.

§ 103. The Constitutional Convention on September 5, 1787, through its Committee of Eleven, apparently was so confident of the broad area of invention to be covered that it included both the "sciences" and "the useful arts." As reported, the insertion of this section was adopted without debate.[1]

Prior to the foregoing, Mr. Madison on Saturday, August 18, 1787, when in Convention, "submitted, in order to be referred to the Committee of Detail, the following powers as proper to be added to those of the General Legislature. * * *

"To encourage by premiums and provisions, the advancement of *useful* knowledge and discoveries. * * *"

Then these propositions upon being referred to the Committee on Detail which prepared the Report, upon Motion of Mr. Pinckney, the following was adopted *unanimously*:

"To grant patents for useful inventions." [2]

It is significant that reference to "scientific discoveries" came later. The interest of the new leaders of the new nation was in the more practical "useful" area.[3] The Convention was obviously of the mind that "useful inventions" were more essential; and § 103 is essentially for that purpose because it provides that there is invention unless it is "obvious" to a man of "ordinary" skill in the art that, considering the matter as a "whole," there is anticipation.

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[1] Ibid.

[2] Id. pp. 563-4.

[3] *"Jefferson and Madison"* by Adrienne Koch, pp. 18-21; Alfred A. Knopf, Inc., 1950.

II. Under the Patent Act of 1952 the effect of the Congressional provision that patents are granted to promote "the useful arts" is applied under Section 103 of the Patent Act of 1952.

The new Act raises the question: "What is the purpose of the patent law?" Is it limited to "pushing back the frontiers of science and physics" or is it equally for the more humble purpose of promoting the "useful arts" as stated by the Constitution[1] rather than being limited to the higher realms of the more extraordinary accomplishments of scientific and physical discoveries?

This new Act raises this fundamental question because apparently it is now the intent of the Congress, we believe, to take the determination of invention out of the hands of highly skilled patent experts and place it in the hands of the "ordinary" worker in the "useful arts" as contrasted with confining it solely to the activities of the expert scientists and physicists.

Under this Act the test of invention has been changed[2] to whether or not the invention would be "obvious" to an "ordinary person skilled in the art," considering the invention *"as a whole"* compared to the prior art as a whole.

The Court below, on the merits, did not apply this rule to the instant case finding that the discovery of an unpredictable chemical reaction in a new sequence producing a new result was not invention because anticipation

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[1] Constitution of the United States, Article I, Section 8, cl. 8 reads: "The Congress shall have power * * * to promote the progress of science and **useful arts** by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries."

[2] Previously the test was whether "an expert" could find anticipation in the prior art and could reconstruct the alleged patentable invention by selecting equivalents in different prior art sources.

could be spelled out by assembling diverse elements *by an expert* from prior chemical patents for anticipation; and by treating successive chemical reactions the same as simultaneous reactions, contrary to § 103 of Title 35 U. S. C. (Patent Act of 1952). The decisions of this Court under the next point explain why, as this Court has held, such differences are invention.

III. The court decisions below conflict with this Court's decisions that (a) in chemical cases there is no prevision and prediction; and (b) that what is done in chemical cases concurrently is different from that which is done successively as reactions in chemistry depend fundamentally upon such timing of chemical steps.

The Courts below held that the invention under examination showed performing chemical reactions concurrently as contrasted with the prior art where reactions took place successively; and that this difference in chemical cases was not invention, although producing a novel and unexpected result. This was error.

There is no prediction or "prevision" in chemistry as held by this and other Courts. *Corona v. Dovan,* 276 U. S. 358, 368-9; *Aeration Processes, Inc. v. Lange, et al.,* 196 F. (2d) 981 (CA 8); *Donner v. Sheer,* 64 F. (2d) 217 (CA 8); *United Chromium, Inc. v. International Silver Co.,* 53 F. (2d) 390, 393 (DC D. Conn.); *General Electric Co. v. Laco-Philips Co.,* 233 Fed. 96, 103 (CA 2); *Naylor v. Alsop,* 168 Fed. 911 (CA 8).

This Court has held that in chemical cases that which is done concurrently is invention over that which has been done successively or vice versa. *American Wood Paper Co. v. Fiber Disintegrating Co.,* 23 Wall. 604; *Corona v. Dovan,*

276 U. S. 358, 368-9; *Minerals Separation v. Magma Co.*, 280 U. S. 400, 403; *Kuehmsted v. Farbenfabriken of Elberfeld Co.*, 179 Fed. 701, 702-5 (CA 7).

IV. The public interest would be served by an early settlement of the question whether the Patent Act of 1952 is a mere codification or a revision of the law as set forth in prior statutes, particularly as to the new Section 103, dealing with invention.

The Court below held that there was no difference between the old law and the revised statutes on the subject of invention under § 103 of the Patent Act of 1952. (R. 195-7.) This decision is in conflict with the statements made in the proceedings of the Congress[1] based upon nearly four years of hearings; it is contrary to the title of the Act that it was a "revision" as well as a codification: "An Act to *revise* and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled 'Patents'." (Emphasis ours.)

The Bar, as shown by testimony in the hearings on revision and since the passing of the Act, interpret the Act as new in § 103.[2]

The new standards of invention under the § 103, which is a wholly new section of the statute[3] for which

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[1] See "Patent Law Codification and Revision" HEARINGS before Subcommittee No. 3 of the Committee on the Judiciary House of Representatives, Eighty-Second Congress, First Session on H. R. 3760, June 13, 14 and 15, 1951 Serial No. 9; 82nd Congress, 2d Session House Report #1923 to Accompany H. R. 7794, May 12, 1952.

[2] "The New Patent Statute: Congress Revitalizes the Patent System" by Karl B. Lutz, American Bar Association Journal, March, 1953, Vol. 39, pp. 209-212.

[3] "Journal of the Patent Office Society," August, 1952, Vol. 34, No. 8.

there has been no previous counterpart, has three features which set up a new standard of invention: the comparison between the subject matter sought to be patented and the prior art is on the basis of considering "the subject matter as a whole": thereby eliminating the prior practice of picking out a piece here and a piece there by expert witnesses from the prior patents and combining them to make out anticipation of an invention.

Section 103 also requires that the "subject matter as a whole would have been obvious." By "obvious" it is meant that it is apparent without any study or experimentation.[1]

The third condition of the new statute is that the invention must have been "obvious," not to an expert, but "to a person having ordinary skill in the art."

If the Court below had followed § 103 as plainly written and as supported by the hearings before the Congress showing the intent of Congress, the decision below would have found invention. *The decision below was based upon the erroneous theory that, while no prior art patent showed the catalyst, it was correct as a matter of law for experts to pick out a part here and a part there from prior patents and by combining them by patent experts, in the light of the invention, find there was no invention.* Things which are not "obvious" to an *ordinary* worker in the art when considering *"the subject matter as a whole"* of a patent might well be plain to a hired expert who comes to the problem with the inventor's solution before him. The Congress has recognized and confirmed in the new § 103 that what may be plain to an expert as a matter of hindsight with the benefit of the invention before him is not the true test of invention.

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[1] "Easily discovered, seen or understood; plain; evident;" etc. *Webster's International Dictionary*, 2nd edition, unabridged.

PRAYER.

WHEREFORE, Your petitioners respectfully pray that writ of certiorari be issued to the United States Court of Appeals for the District of Columbia Circuit to the end that this cause may be reviewed and determined by this Court in accordance with the principles of law heretofore announced by it; that the decree of the Court of Appeals for the District of Columbia Circuit be reversed as to the finding of invalidity for lack of invention of the pending patent application Serial Number 653,932, filed March 12, 1946 in the name of William A. Waldie; and that the petitioners be granted such other and further relief as may be deemed proper.

NEW WRINKLE, INC. AND
WILLIAM A. WALDIE,

By H. A. TOULMIN, JR.,
Counsel for Petitioners.

F. E. DRUMMOND,
D. J. HANLON, JR.,
Of Counsel.

In the Supreme Court of the United States

OCTOBER TERM, A. D. 1953.

No. .....

NEW WRINKLE, INC., and WILLIAM A. WALDIE,

Petitioners,

v.

ROBERT C. WATSON, Commissioner of Patents,

Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

THE OPINIONS OF THE COURTS BELOW.

The Memorandum Opinion of the District Court is found on pages 13A-16A of the Record. The Judgment is found on page 16A of the Record. The opinion of the Court of Appeals for the District of Columbia Circuit (Circuit Judges Proctor, Bazelon and Fahy, Circuit Judge Fahy writing the opinion) appears at pages 209-213 of the Record. The opinion of the Court of Appeals is reported at ____ F. (2d) ____ (CA D. C.), 96 U. S. P. Q. 436.

The cases believed to sustain jurisdiction are:

Statutory Issue: *United States v. Ruzicka et al., Trading as Seeley Dairy,* 329 U. S. 287.

Serious Hindrance to Effective Administration of Patent Law by Court of Appeals Decision: *Rothensies, Collector of Internal Revenue v. Electric Storage Battery Co.,* 329 U. S. 296.

Court of Appeals Misapplied Supreme Court Opinions: *McCandless, Receiver v. Furlaud et al.*, 296 U. S. 140; *Upshaw v. United States*, 335 U. S. 410.

STATEMENT OF THE CASE IN PETITION.

The foregoing Petition contains a summary of the material facts necessary to an understanding of the reasons relied upon for the allowance of the writ as well as a statement of the questions involved in the case.

SPECIFICATION OF ERRORS.

The specification of errors herein relied upon are those reasons incorporated generally in the reasons set forth in the Petition as grounds for its allowance.

ARGUMENT.

I. The Patent Act of 1952 is a new act in Section 103 providing a basis for invention recognizing the constitutional provision that the patent laws are for the promotion of the "useful arts," as well as to promote the progress of science.

The Court of Appeals below in its decision in the instant case took the position that there was no change between the revised statutes and the Patent Act of 1952 as the latter was only a "codification," overlooking the proceedings in the Congress and the title of the Act, which reads:

> "An Act to *revise* and codify the laws relating to patents and the Patent Office, and to enact into law Title 35 of the United States Code entitled 'Patents'." (Italics added.)

The Bar has shown both by testimony in the hearings of the Congress and since the enactment of the statute that it does not so understand that the Patent Act of 1952 is a mere codification: it is believed that it is a *revision* as well as codification, particularly with reference to § 103.[1] To others it is said to mean these sections "stabilize" the law and to still others it means older decisions are adopted and later decisions of the Courts are rejected.[2]

Mr. Bryson, from the Committee on the Judiciary, in his report[3] on this bill (H. R. 7794) said the in-

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[1] "The New Patent Statute: Congress Revitalizes the Patent System," by Karl B. Lutz (of the Pittsburgh, Pa. Bar), American Bar Association Journal, March, 1953, Vol. 39, pp. 209-212.

[2] Journal of the Patent Office Society, Vol. 35, No. 4, April, 1953, p. 233, entitled "The Effect of Section 103 of the Patent Act of 1952 Upon the Patent Laws."

[3] Journal of the Patent Office Society, Vol. 34, No. 8, August, 1952, pp. 543-683, entitled "Patent Act of 1952," comprising a complete comparative analysis between the old laws and the new Patent Act of 1952.

tent was "to **revise**, codify, and enact into law title 35 of the United States Code entitled 'Patents', and recommends that the bill do pass. The present bill has been substituted for an earlier bill (H. R. 3760), on which hearings were held, and contains changes recommended by the subcommittee. As its title indicates, **the purpose of the bill is to revise** and codify the laws relating to patents and enact into law title 35 of the United States Code entitled 'Patents'."

He further stated under "General Description of Bill" that **"there are a number of changes in substantive statutory law."**[1]

In view of the foregoing, may we suggest that it was the intent of the Congress that this be an entirely new section setting up new standards of invention. The decision of the Court of Appeals below was in error in holding in the instant case (Appeal No. 11,475) that there was no difference between the old and new law on invention and that the new law was a mere codification of the existing statutes.

The comment in the Journal of the Patent Office Society[2] is this: **"There is no provision corresponding to the first sentence explicitly stated in the present statutes,** * * *" (p. 587.)

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[1] Journal of the Patent Office Society, Vol. 34, No. 8, August, 1952, p. 554. As stated by Mr. Bryson and quoted by this Journal of the Patent Office Society at page 557: "Section 103, **for the first time in our statute**, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the court. * * * **This section should have a stabilizing effect and minimize great departures which have appeared in some cases.**" (Emphasis ours.)

[2] Ibid.

II. If the Court of Appeals below had given the normal effect to the Section 103 of the Patent Act of 1952, as set forth in the hearings before the Congress, it would have found that the instant invention of a catalyst resulting from long experimentation was unpredictable because of a complex chemical reaction.

This Court has frequently held that in chemical cases there is "no prevision in chemistry." [1] This is particularly true of "catalysts" which are curious chemical compositions that react to start a chain of chemical reactions of other chemical combinations. The great oil industry and atomic energy are typical industries dependent upon the unexpected reactions of "catalysts." [2] *Corona v. Dovan*, 276 U. S. 358, 368-9; *Minerals Separation v. Magma Co.*, 280 U. S. 400, 403; *Kuehmsted v. Farbenfabriken of Elberfeld Co.*, 179 Fed. 701, 702-5 (CA 7).

There is another rule of law established by this Court which the new Patent Act of 1952 emphasizes: **that that which is done sequentially may be entirely different, and therefore invention, than that which is done simultaneously, or vice versa, in chemical cases.** Section 103 has put into words what this Court has held along these two lines of authority. *American Wood Paper Co. v. Fiber Disintegrating Co.*, 23 Wall. 604.

The new Patent Act of 1952 puts into law what this Court has held, that, there being "no prevision," there can be no anticipation, particularly in chemical cases, by merely looking at the prior art and guessing that parts of it could be used to do what the inventor did. To anticipate

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[1] In *Corona v. Dovan*, 276 U. S. 358, 368-9, Mr. Chief Justice Taft said: "The catalytic action of an accelerator **cannot be forecast by its chemical composition, for such action is not understood and is not known except by actual test.**" (Emphasis ours.)

[2] Ibid.

under the new law, this must be "obvious," that is, need no experimentation or toil to reach the result; and that anticipation must be so plain as to be obvious to a person of ordinary skill in the art. This eliminates patent experts who can reconstruct the invention by picking a part here and a part there, as the Patent Office experts did in this case, to reconstruct the invention.

The decision of the Court below affirming the Patent Office is contrary to the aforementioned cases on chemistry decided by this Court.

III. The Patent Act of 1952 applies to this case (Section 4a): and when it so applies the discovery of a catalyst, the elements of which operate sequentially in a manner not found in the prior art arrived at by long experimentation, constitutes invention because invention is not negatived under the Patent Act of 1952 unless the invention's identity with the prior art is so plain as to be "obvious" to "a person of ordinary skill in the art" on a basis of considering "the subject matter as a whole" and not in individual elements to be picked out of the prior art.

The record in this case shows that Waldie had to do extensive experimentation before he arrived at this invention. He is a recognized expert in the art, but even to the expert it was not obvious, because it required long toil and experimentation to reach the goal.

Under the new Patent Act of 1952 there is lack of invention *only* if the identity with prior art is so plain as to be *"obvious"* to "a person of *ordinary* skill in the art." Prior to the new Patent Act lack of invention could be proved by the testimony of patent experts who could perceive identities in the prior art with the patentable

idea in question that no other mortal man could see. The Congress was conscious of this practice that made it difficult to sustain any patent.

This statute is Congress' way of saying, "the testimony of the patent expert" is no longer the basis of determining invention: if the identity of the prior art with the invention in question is not so plain to the "*ordinary*" person in the art viewing it "as a whole" so as to be "obvious," then there is invention.

Change in standard of invention.

Thus, the Congress has further changed the test under the old patent law that to one "skilled in the art" (patent expert) it would be apparent that there was no difference between the patented subject matter or the subject matter to be patented and the prior art if the "expert" could fabricate anticipation by assembling prior disclosures into a new unit like the patent in suit.

Here again the Congress has altered the standard of invention markedly by requiring the identity between the prior art and the alleged new development **to be so close** that it would be "obvious" to a person "of ordinary skill," looking at the invention "as a whole" and not piecemeal.

This is far different than saying that a person skilled in the art, meaning a patent expert, could see that there was no difference because of the exercise of his high degree of skill by which he could find identities that would not be obvious to the ordinary person working in the art. **It also eliminates piecemeal anticipation for the subject matter must be considered as a whole.**[1]

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[1] As elsewhere pointed out the proposed Patent Act was changed, contrary to the recommendations of the Commissioner of Patents, by his representative Federico, from a test by a man "skilled in the art" **to one of ordinary skill**—the Patent Office was strongly opposed to this practical test put into the statute by Congress. Hearings, June 13, 1951, Serial #9. **The change to this new invention standard by the Congress was intentional.**

Section 103 of the new Patent Act of 1952 is a wholly new section of the statute. There has never been any section like it before.[1] It has three features in the first sentence:

(a) A comparison between the subject matter sought to be patented and the prior art is on the basis of considering *"the subject matter as a whole." This was for the purpose of eliminating building up anticipation by picking a piece here out of one prior patent and a piece there out of another prior patent, and thereby building up a composite anticipation from many patents.* That was the error of the Courts below.

(b) Section 103 requires that the "subject matter as a whole would have been *obvious.*" This is the second condition of being "obvious" requiring that an ordinarily skilled person must look at the subject matter itself to be patented as a whole and a unit and the prior art must also be looked at as a unit, and that comparison must make it obvious that there is no invention. By "obvious," *it is meant that it is apparent without any study or experimentation.* If there be necessity for experimentation to reach results, as in the instant case, then the matter could certainly not have been "obvious." The Patent Office makes no claim here that it was not necessary to do experimental work to arrive at this result of the Waldie application.

(c) The statute goes farther and says that what is "obvious" must not be to the expert, but "to a

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[1] 82nd Congress, 2d Session, House Report #1923 to Accompany H. R. 7794, May 12, 1952, p. 18; Journal of the Patent Office Society, August, 1952, Vol. 34, #8, pp. 587-8.

person having *ordinary* skill in the art." In the history of this section before Congress, the Commissioner of Patents' representative, Federico, on page 38 of the Hearings of June 13-15, 1951, Serial No. 9, referred to § 103 as calling for "a person skilled in the art." It was at a later date that the word "ordinary" [1] was inserted before "persons skilled in the art."

Purpose of revised Patent Act.

"What is the purpose of the patent law?" Is it limited to "pushing back the frontiers of science and physics" **or does it also now include the more humble purpose of promoting the "useful arts" as stated by the Constitution** rather than being limited to the higher realms of the more extraordinary accomplishments of scientific and physical discoveries?

This new section of the law is, therefore, for the purpose of giving the Courts a wholly new basis of judging invention and one that is much more liberal towards the inventor than ever before in our history.

This is shown by the fact that the last sentence of § 103 says, **"Patentability shall not be negatived by the manner in which the invention was made."**

This sentence is confirmatory of the hearings by the Congress which resulted in the first sentence of § 103 and this second sentence, with the intent of broadening the area of invention, and changing the standard of invention by "stabilizing" it as Mr. Bryson said[2] by remov-

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[1] "of common rank, quality, ability;" Webster's International Dictionary, 2nd edition, unabridged.

[2] "Journal of the Patent Office Society," August, 1952, Vol. 34, No. 8, p. 557; House Report No. 1923, from the Committee on the Judiciary, House of Representatives to Accompany H. R. 7794, May 12, 1952, p. 7.

ing invention exclusively from the "genius" class and from the higher realms of physics and chemistry where only one who pushed back these frontiers could be an inventor.

The report from the Committee on the Judiciary of the House of Representatives of May 12, 1952 says as to the first sentence of this section, "This paragraph is added with the view that the explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out." (H. R. 7794, p. 18.) Thus, the Committee also said (p. 18 of its report, May 12, 1952), "**There is no provision corresponding to the first sentence explicitly stated in the present statutes.** * * *." It is significant in these hearings that when Patent Office witnesses appeared, each of them urged that the tests should be by a person "skilled in the art," that is, an expert and not an ordinary person. **This adherence to the old law was rejected by the Congress.**

Witnesses also urged that the prior art and the subject matter to be presented should not be considered "as a whole" because the Patent Office experts always desired to break down an invention into its elements so as to find such elements here and there in prior patents and combine them in the light of the invention, to try to spell out anticipation, a doctrine frequently rejected by the Courts. It is that same effort that has been made in this case *because the District Court found that it could find no one patent to anticipate the whole invention.* (R. 15 A.)

As the report[1] from the Committee on the Judiciary of the House of Representatives on May 12, 1952, said:

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[1] House Report No. 1923, Report from the Committee on the Judiciary, House of Representatives, to Accompany H. R. 7794, May 12, 1952.

"The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius." (p. 18.)

The August, 1952 issue of the *Journal of the Patent Office Society,* Vol. 34, No. 8, pages 587-8, has this to say about §103:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been *obvious at the time* the invention was made *to a person having ordinary skill* in the art to which said subject matter pertains. * * *
>
> "Section 103—New Section:
>
> **"There is no provision corresponding to the first sentence explicitly stated in the present statutes,** but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.
>
> "The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, *it is immaterial whether it resulted* from long toil and experimentation or *from a flash of genius.*" (Emphasis ours.)

Please note that it too, recognizes that talent of a high order such as genius, or of any other type, is not a pre-

requisite of being judged an inventor—**the day of the plain man contributing a "useful" idea has arrived.**

Conditions Essential in §103.

Unless the respondent can meet the following statutory conditions, it must fail on its claim of lack of invention:

(1) The differences between the invention and prior art are so small that the *subject matter as a whole* would have been *obviously old.*

(2) At the time the invention was made (not to an expert later);

(3) To a "person having ordinary skill in the art" (not an expert—a Patent Office Examiner is certainly to be classed as an expert); and

(4) That the invention must be viewed "as a whole."

The difference between an "ordinary" person and an "expert" is well recognized by the Courts.[1]

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[1] " 'Expert witness,' must have acquired a knowledge beyond that of *ordinary* witnesses. *Daniel v. State,* 17 So. 2d 542, 544, 31 Ala. App. 376.

"The distinction between 'expert' and 'nonexpert witness' is that nonexpert gives result of process of reasoning familiar to everyday life, while expert gives result of process of reasoning which can be mastered only by special scientists. *Phillips v. Tidwell,* 174 S. W. 2d 472, 477, 26 Tenn. App. 543.

"A witness is an 'expert witness' and qualified to give expert testimony if the judge finds that to perceive, know or understand the matter concerning which the witness is to testify, requires special knowledge, skill, experience or training, and that witness has the requisite special knowledge, skill, experience or training. *Bratt v. Western Air Lines, Inc.,* 155 F. 2d 850, 853 (C. A. 10).

"To qualify as 'expert witness,' witness should have such special knowledge of the subject about which he is to testify that he can give the jury guidance in solving a problem for which their equipment of average knowledge is inadequate. *Wilson v. State,* 26 A. 2d 770, 773, 181 Md. 1." (*Words and Phrases,* Permanent Edition, Vol. 15A, pages 469-470.)

The last sentence in § 103 also indicates a drastic change in the standards, that "Patentability shall not be negatived by the manner in which the invention was made," is said to mean that the former requirement, under the old cases that the invention must be a "flash of genius" and must not be the product of toil and labor of ordinary people in a large laboratory, has been discarded.

IV. Public importance of interpreting the meaning of the revised Patent Act early in its history so that the courts below and the public will be guided as to the correct interpretation of the new statutes.

The field of catalysts and the extent to which they can be protected as invention and the field of chemistry in general where chemical reactions, as often held by this Court and Courts of Appeal,[1] are unpredictable, **affect industries that are the very foundation of this nation's safety and success in chemistry, physics and atomic energy.** Protecting these matters is no light thing and early certainty under this revised Patent Act of 1952 raises a fundamental question.

The possession and assertion of patent rights are "issues of great moment to the public." *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U. S. 238, 246. See also *Mercoid Corp. v. Mid-Continent Investment Co.*, 320 U. S. 661, 665; *Morton Salt Co. v. Suppiger Co.*, 314 U. S. 488; *United States v. Masonite Corp.*, 316 U. S. 265, 278.

A patent by its very nature is affected by the public interest as it is a temporary delegation of sovereign control and a grant of monopoly for a temporary period in consideration of the economic advantages of the nation.

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[1] *Corona v. Dovan*, 276 U. S. 358; *Naylor v. Alsop*, 168 Fed. 911 (CA 8); *Aeration Processes, Inc. v. Lange, et al.*, 196 F. (2d) 981 (CA 8); *Donner v. Sheer*, 64 F. (2d) 217 (CA 8).

Precision Instrument Mfg. Co. et al. v. Automotive Maintenance Machinery Co., 324 U. S. 806, 816.

We earnestly submit that this Court should order up this case for early consideration of this fundamental issue, worthy of the attention of this Court.

Respectfully submitted,

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Counsel for Petitioners.

F. E. DRUMMOND,
D. J. HANLON, JR.,

Of Counsel.

"§ 63. **Bill in equity to obtain patent.** Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. R. S.

§4915; Feb. 9, 1893, c. 74, §9, 27 Stat. 436; Mar. 2, 1927, c. 273, §11, 44 Stat. 1336; Mar. 2, 1929, c. 488, §2(b), 45 Stat. 1476; Aug. 5, 1939, c. 451, §4, 53 Stat. 1212." Title 35, U. S. C. A.

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In the Supreme Court of the United States

OCTOBER TERM, 1953

No. 141

NEW WRINKLE, INC., AND WILLIAM WALDIE, PETITIONERS

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The memorandum opinion of the United States District Court for the District of Columbia (R. 13-16) is reported at 102 F. Supp. 814. The opinion of the United States Court of Appeals for the District of Columbia Circuit (R. 209-213) is reported at 204 F. 2d 35.

JURISDICTION

The judgment of the Court of Appeals was entered on March 19, 1953 (R. 214). A petition for a rehearing was denied on April 7, 1953 (R. 220). The petition for a writ of certiorari was filed on

June 24, 1953. The jurisdiction of this Court is presumably invoked under 28 U.S.C. 1254(1).

QUESTION PRESENTED

Whether petitioners' application for a patent was properly refused for lack of invention over the prior art.

STATUTE INVOLVED

Section 103 of Title 35 of the United States Code, as revised, Act of July 19, 1952, c. 950, 66 Stat. 792, 798, provides as follows:

Conditions for patentability; non-obvious subject matter

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT

This action was commenced in July, 1949, under R. S. 4915, as amended, 35 U.S.C. (1946 ed.) 63[1]

[1] R. S. 4915, which authorized the filing of a bill in equity in the district court to secure a patent in circumstances where the patent application was refused by the Board of Appeals, was repealed, effective January 1, 1953, by Section 5 of the Act of July 19, 1952, 66 Stat. 792, 815-816, which revised and enacted into law Title 35 of the United States Code. Existing rights and liabilities were not affected by the repeal. Its provisions were reenacted into law, with changes not material here, as §§ 145 and 146 of the revised Title 35. 66 Stat. 803.

against the Commissioner of Patents by the individual petitioner Waldie (applicant) and the corporate petitioner New Wrinkle, Inc. (assignee) to secure the allowance of the Waldie patent application, Serial No. 653,932, filed March 12, 1946, on an alleged invention of a "Wrinkle Catalyst". The District Court dismissed the complaint for want of invention over the prior art. The Court of Appeals affirmed.

1. *Petitioners' application.*—The application relates to the art of producing coating compositions which will create a wrinkle finish when applied to various types of surfaces and dried (R. 80-89). The method of compounding the composition consists of adding a dry texture modifying powder to a non-wrinkling oil or varnish base that has been heated to a temperature of from 350° F. to 420° F., raising the temperature of the mixture to approximately 600° F., cooling the mixture to about 350° F., and finally adding a thinner and drier (R. 82). The modifying powder is composed of (1) an oil reactant selected from the group of compounds consisting of maleic acid, maleic acid anhydride and fumaric acid; and (2) a texture producer (referred to as a drier) selected from the group of compounds consisting of manganese borate, cobalt acetate and lead oxides. (R. 84-5) A proportion of from 4:1 to 1:1 with regard to oil reactant and texture producer purportedly yields satisfactory results (R. 86). The powder may also contain dehydrating agents, such as bentonite or silica gel (R. 86). The essence of the alleged invention is said to be "the

conversion of any non-wrinkling varnish * * * into wrinkle finishes by the addition of a dry powder composed at least of an oil reactant ingredient and one texture modifying substance" (R. 86).

The claims defining the alleged invention are set forth in the complaint (R. 2-9). They may be grouped as follows:

1. Claims 1 to 4, inclusive (R. 5), which define a dry mixture of the materials denominated a texture modifying powder.

2. Claims 5, 6, 7, and 9 (R. 5, 6), which define an oil or varnish composition that dries to a wrinkle finish, the composition comprising a non-wrinkling oil or varnish base and the texture modifying powder of claims 1 to 4.

3. Claims 8, 10, and 11 (R. 6, 7), which define the method or process of converting or producing a wrinkling oil or varnish from a non-wrinkling oil varnish base. A two-stage heating process is involved, the modifying powder being added after the first stage.

2. *Prior art*—On October 18, 1932, patent 1,883,408 (R. 176-181) was granted to Root relating to coating compositions of the varnish or enamel type which result in the production of wrinkle finishes; the compositions generally containing a wrinkling oil with admixtures of non-wrinkling oil, the latter being less than half of the oil mixture (R. 177, col. 2, lines 95-128). The non-wrinkling oil may be a raw oil, a blown oil, or a boiled oil. Driers, such as cobalt, acetate, red lead, or manganese borate, are said

to be important elements of the composition because the wrinkling effect is said to be determined to some extent by the rate of oxidation of the oil (R. 178, col. 1, lines 55-63).

On March 13, 1934, patent 1,950,417 (R. 183-189) was granted to Root describing essentially the same coating composition as that of the earlier patent, emphasizing the use of non-wrinkling oils, such as raw oils or boiled oils (R. 186, col. 2, lines 80-87). This patent further describes a method of compounding which includes heating of the oil and resin to disperse the latter in the former, adding part of the drier and further heating to 565° F, cooling and adding more oil and drier with heating to about 520° F, and finally, reducing the temperature of the mixture to 390° F, and adding solvents, dilutents and thinners (R. 186, col. 1 & 2, lines 54-79).

On January 8, 1946, patent 2,392,346 (R. 190-193) was granted to Waldie which discloses a wrinkle varnish composition produced from oils such as unblown linseed oil (R. 190, col. 1, lines 45-48). Oil and resin are heated together about 400° F to disperse the resin therein, then maleic acid anhydride is added and the temperature of the mixture raised to about 550°. After the mixture cools to about 400° F, solvent and drier, which may be cobalt or manganese compounds, are added. (R. 190, col. 2, lines 7-22; R. 191, col. 1, lines 74-75.)

3. *Proceedings below*—Petitioners' claims were refused by the Patent Office examiner on the ground, *inter alia,* that they were unpatentable over the Waldie patent, in view of the patents to Root (R. 117). The decision of the examiner was af-

firmed on this ground by the Patent Office Board of Appeals (R. 132-136).[2]

Thereafter, petitioners brought the instant suit under R. S. 4915, 35 U.S.C. (1946 ed.) 63, in the United States District Court for the District of Columbia against the Commissioner of Patents. After a trial *de novo,* the District Court held that petitioners had not established that the product of the alleged invention was substantially different from that which was produced under the prior art and further ruled that, since petitioners had merely added to the non-wrinkling oil "simultaneously that which previously had been added sequentially", the finding of the Patent Office that the claimed invention was anticipated by the prior art was reasonable (R. 13-16). Petitioner then appealed to the Court of Appeals which affirmed the decision of the district court (R. 209-213). Noting that on January 1, 1953, while the appeal was pending, the revised Title 35 came into effect, and recognizing its applicability to the present case,[3] the court held

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[2] The Board of Appeals also agreed with the determination of the examiner that claims 1 through 4 were aggregative in that the components of the dry mixture described therein do not react with each other and the mixture possesses no utility in itself (R. 173-174). The District Court and Court of Appeals arrived at the same conclusion (R. 15, 210) and petitioners have not here questioned its correctness.

[3] Section 4 (a) of the Act of July 19, 1952, 66 Stat. 815, revising and enacting into law Title 35 of the United States Code, provides that that Act shall take effect on January 1, 1953, and "shall apply to further proceedings on applications pending on such date." It was held, prior to January 1, 1953, that a proceeding under R. S. 4915 was part of the application for a patent or for registration of a trade-mark. *Tomlinson of High Point* v. *Coe,* 123 F. 2d 65 (C.A.D.C.); *Barron-Gray Packing Co.* v. *Kingsland,* 171 F. 2d 576 (C.A.D.C.), certiorari denied, 336 U.S. 944.

that its provisions did not assist petitioners. Specifically, the court directed its attention to Section 103, which provides in relevant part that "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art" a patent may not be obtained. After reference to the legislative history of the Act, which indicates that the provision was merely a codification of existing law (see p. 9 *infra*), the court said (R. 212-213):

> Plainly any difference whatever from the prior art is not in and of itself sufficient to make out patentable invention under the new statute. We need not determine now just what is its effect; for whether the required difference results from "creative talent", or is described as "sufficiently great to warrant a patent", or, in language found in the present statute, is such that the "subject matter as a whole" would not have been "obvious * * * to a person having ordinary skill in the art", we think it clear that the slight difference over known developments which might be attributable to these claims is devoid of patentability.

ARGUMENT

Petitioners seek by this action to secure the allowance of a patent on a "Wrinkle Catalyst". The courts below have determined, as did the Patent Office in the first instance, that petitioners' application fails to disclose invention over the prior art.

In so doing, we submit, these tribunals correctly applied the well-settled standard of invention, recently codified by Congress, to the facts before them. Accordingly, further review is not warranted.

1. Contrary to petitioners' belief, the first sentence of Section 103 of the revised Title 35 (p. 2 *supra*) represents nothing more than the codification of the well established principle laid down in *Hotchkiss* v. *Greenwood,* 11 How. 248, 267, that, where no more ingenuity or skill is required than that "possessed by an ordinary mechanic acquainted with the business" to make the invention which was the subject matter of the patent, there is an "absence of that degree of skill and ingenuity which constitute the essential elements of every invention". See also *Hobbs* v. *Beach,* 180 U.S. 383, 393; *Atlantic Works* v. *Brady,* 107 U.S. 192, 199-200; *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.,* 220 U.S. 428, 435; *Saranac Automatic Machine Corp.* v. *Wirebounds Patents Co.,* 282 U.S. 704, 711; *Sinclair & Carroll Co.* v. *Interchemical Corp.,* 325 U.S. 327, 330.[4] In reporting out the bill (H.R. 7794) which later became the Act which revised Title 35 of the United States Code, the House Committee on

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[4] "The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head-workmen and engineers is generally adequate to devise * * * Each step forward prepares the way for the next * * * To grant to a single party a monopoly of every slight advance made, except where the exercise of invention, somewhat above ordinary mechanical or engineering skill, is distinctly shown, is unjust in principle and injurious in its consequences." *Atlantic Works* v. *Brady,* 107 U.S. 192, 199-200.

the Judiciary explained the provisions of Section 103 in these terms (H. Rep. No. 1923, 82nd Cong. 2nd Sess. p. 7):

> Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not sufficiently great to warrant a patent. * * *
>
> [The provision] paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness.

See also S. Rep. 1979, 82nd Cong. 2nd Sess. p. 6; Revision Notes to Section 103, H. Rep. No. 1923, 82nd Cong., 2nd Sess., p. 18; Zinn, *Commentary on New Title 35*, 2 1952 U.S. Code Cong. & Adm. News, pp. 2507, 2512-2513; *General Motors Corp.* v. *Estate Stove Co.*, 203 F. 2d 912 (C.A. 6).[5]

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[5] Petitioners' assertion that the Patent Bar interprets the first sentence of Section 103 as setting up a new standard of invention is not correct. The authors of the articles cited in footnotes 1 and 2 on p. 15 of the petition both expressly state that the provision codifies existing law. See Lutz, *The New Patent Statute: Congress Revitalizes the Patent System*, 39 A.B.A. Journal 209, 210; Goodman, *The Effect of Section 103 of the Patent Act of 1952 Upon the Patent Laws*, 35 Journal of the Patent Office Society pp. 233-4. And the article to which petitioners refer in footnote 3 on p. 15 of the petition simply contains the House Committee on the Judiciary's explanation of the Section, as set forth above. See *Patent Act of 1952*, 34 Journal of the Patent Office Society, pp. 587-8.

Thus, as the Court of Appeals observed (R. 211), petitioners can derive no additional comfort from the enactment of Section 103 subsequent to the proceedings in the Patent Office and the District Court.[6] If the alleged invention was not patentable before January 1, 1953, when the revised Patent Code took effect, it is not patentable now. And "the question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention" remains "one of fact". *Thomson Spot Welder Co.* v. *Ford Motor Co.*, 265 U.S. 445, 446. See also *Williams Mfg. Co.* v. *Shoe Machinery Corp.* 316 U.S. 364, 367; *Goodyear Tire & Rubber Co. Inc.* v. *Ray-O-Vac Co.*, 321 U.S. 275, 278; *Bischoff* v. *Wethered*, 9 Wall. 812, 814; *Battin* v. *Taggert*, 17

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[6] The second sentence of Section 103, providing that "Patentability shall not be negatived by the manner in which the invention was made", has, as indicated by the court below, no bearing on this case. It means only that it is immaterial on the question of patentability whether the alleged invention resulted from long toil and experimentation or from a spontaneous "flash of genius." See Revision Notes to Section 103, H. Rep. No. 1923, 82d Cong., 2d sess., p. 18. While the earlier cases were to this effect (see *e.g. Diamond Rubber Co.* v. *Consolidated Rubber Co.* 220 U.S. 428, 435), it has been thought that this Court indicated in *Cuno Engineering Corp.* v. *Automatic Devices Corp.* 314 U.S. 84, 91, that a new device in order to be patentable "must reveal the flash of creative genius". But cf. *Sinclair & Carroll Co.* v. *Interchemical Corp.*, 325 U.S. 327, 330-331; *Brown & Sharpe Mfg. Co.* v. *Kar Engineering Co.*, 154 F. 2d 48, 51 (C.A. 1), certiorari denied, 328 U.S. 869; *Falkenberg* v. *Bernard Edward Co.*, 175 F. 2d 427, 428-9 (C.A. 7), certiorari denied, 338 U.S. 870; *Trabon Engineering Corp.* v. *Dirkes*, 136 F. 2d 24, 27 (C.A. 6); *In re Shortell*, 142 F. 2d 292, 295-6 (CCPA). In any event, it was never suggested by the Patent Office or the District Court that the application here involved was unpatentable because it was the product of experimentation rather than that of a "flash of genius."

How. 74, 85.[7] In this instance, both of the courts below resolved the question of fact against petitioners, and a settled rule of this Court makes concurrent findings of two courts below final here in the absence of exceptional error. *Comstock* v. *Group of Investors*, 335 U.S. 211, 214. Petitioners have failed to demonstrate that exceptional error was committed.[8]

2. When the claims in the instant application are read in the light of the prior art, the correctness of the Court of Appeals' determination that the difference is devoid of patentability becomes readily apparent. As petitioners tacitly concede, each element of the coating composition disclosed by the alleged invention is shown by the prior art. Both Root patents disclose the particular driers recited by the instant application for use in the production of wrinkling finishes. Indeed, Root Patent 1,950,417 discloses manganese borate, the specific drier of claims 3, 5, and 7, and teaches that it is an important element in wrinkling compositions, af-

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[7] While the term "mechanical skill" is often employed in denominating the antithesis of "invention", it is clear that the principles herein discussed are applicable to both mechanical and chemical inventions. Cf. *Mandel Bros.* v. *Wallace*, 335 U.S. 291, 295; *Dow Chemical Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U.S. 320.

[8] It might be noted in passing that, in spite of their contention that a new standard of invention was established by Section 103, petitioners have never suggested that the case should be remanded to the District Court for further proceedings. The Court of Appeals, however, considered the matter *sua sponte* and concluded that, in any event: "The facts so clearly lead to the conclusion we reach that we would not be justified in withholding present disposition" (R. 212).

fecting the rate of oxidation of the wrinkling oil and speeding up the wrinkling process. And Waldie discloses the use, in the production of a wrinkle finish composition, of the same base oil and the same acid oil reactant as the instant claims.

Petitioners' reliance here, as in the court below, is instead on the fact that the alleged invention combines these elements in a new manner. The Waldie patent shows the addition of maleic acid anhydride (the oil reactant) to heated non-wrinkling oil and then, after successively heating and cooling the mixture, the addition of a drier. The process disclosed by the application involves combining the oil reactant and drier into a dry powder mixture, followed by the addition of the heated non-wrinkling oil. Petitioners urge that this difference demonstrates invention and demands the issuance of a patent.

In rejecting this contention, the court below did not take the position, seemingly attributed to it by the petition, that the combination, in a different order, of elements well known in the prior art *cannot* constitute invention. On this record there was no necessity to reach that question. The District Court had found that, although there was testimony to the effect that by adding the oil reactant and drier to the non-wrinkling oil as a unit, instead of separately, as was taught by the Waldie patent, a harder finish and a firmer wrinkle resulted, "there was no showing that the product [produced by virtue of the methodology disclosed in the application]

is substantially different from that produced by the prior art". (R. 15.) The Court of Appeals was thus called upon simply to determine, in circumstances where old elements had been brought together in a compound, involving no new principle and disclosing an old result, whether there had been an exercise of invention or, stated in terms of the statute, whether a difference from the prior art had been produced such that "the subject matter as a whole" would not have been "obvious * * * to a person having ordinary skill in the art".[9] It can hardly be said that, in answering this question in the negative, the court below erred—indeed, an opposite conclusion would be difficult to justify. Cf. *Altoona Publix Theatres* v. *American Tri-Ergon Corp.* 294 U.S.

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[9] For this reason, among others, *Corona Cord Tire Co.* v. *Dovan Chemical Corp.*, 276 U.S. 358; *Minerals Separation* v. *Magma Co.*, 280 U.S. 400; *American Wood Paper Co.* v. *Fibre Disintegrating Co.*, 23 Wall 566; and *Kuehmsted* v. *Farbenfabriken of Elberfeld Co.*, 179 Fed. 701 (C.A. 7), cited by petitioners (Pet. p. 5), are not material to this case. There is nothing in those decisions to support the proposition that the compounding of elements known to the prior art is *per force* invention although neither a new principle nor a substantially new result is revealed. Petitioners' difficulty stems from the fact that they have treated the District Court's view that "*where the result accomplished is substantially the same*, steps taken concurrently or simultaneously are the equivalent of and not patentable over steps taken successively" (R. 15) (emphasis supplied), as if the qualifying phrase was omitted. And cf. *In re White*, 39 F. 2d 974, 975, where the Court of Customs and Patent Appeals said, in reaching the identical conclusion, that:

> In the argument emphasis is laid upon the order in which the ingredients are placed in the mixture. The claims do not, however, assert this order as a necessity, and, in any event, we do not think this constitutes a patentable feature in this case. That surely is a matter which suggests itself to one skilled in the art.

477, 486. And it necessarily follows that the combination is not entitled to the protection of a patent. *Mantle Lamp Co.* v. *Aluminum Products Co.*, 301 U.S. 544, 547.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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JULY, 1953

☆ U. S. GOVERNMENT PRINTING OFFICE: 1953 265793